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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/813,247 03/07/97 AIDA

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EXAMINER

BOURQUE, R

ART UNIT	PAPER NUMBER
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2776

DATE MAILED:

10/13/99

28

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/813,247

Applicant(s)
AIDA, Mitsuhiro

Examiner
Robert Bourque

Group Art Unit
2776

☒ Responsive to communication(s) filed on Sep 25, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 28-38 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 28-35 is/are rejected.

☒ Claim(s) 36-38 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/330,573

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 25

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This action is responsive to communications: Amendment filed 9/25/1999 on application filed on 3/7/1997.
2. Claims 28-38 are pending in the case. Claims 28 and 35 are independent claims.

Priority

3. This application filed under former 37 CFR 1.62 lacks the necessary reference to the prior application. A statement reading "*This is a File Wrapper Continuation of Application No. 08/330,573 filed 10/28/1994, now abandoned.*" should be entered following the title of the invention or as the first sentence of the specification.
4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/330,573, filed on 10/28/1994.

Drawings

5. The drawings are objected to because of informalities discovered during the prosecution of the parent case and listed on the Draftspersons Review PTO-948 dated 12/14/1994, which was attached to a Office Action dated 5/16/1996. Correction is required.

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Claim Objections

6. The numbering of claims is not accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 60-62 been renumbered 36-38. These claims are in improper dependent form, as they depend on claims 44, 49 and 57, respectively. However, claims 44, 49 and 57 are not valid claim numbers in the case and Examiner is unable to determine what claims Applicant is intending to depend from. Therefore, the objected claims have not been considered.

7. Claims 28-38 are objected to because of the following informalities: the claims are replete with grammatical errors and other informalities. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. Claims 28-35 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 28-35, which simultaneously claim both statutory classes, namely, apparatus and method, are indefinite and ambiguous since the claims include method in the preamble and apparatus language in the form of means plus function language. See Ex parte Lyell 17

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USPQ2d 1548 (Bd. PQ & 1 1990). In other words, they are hybrid claims, which are not allowed under 37 CFR 1.75. The Examiner recommends that the Applicant makes either of changes: 1) substitute the word "method" in the preamble for "apparatus", i.e. line 1 and 22 in claim 28; or 2) substitute step language for means plus function language. Similarly, Applicant should make appropriate corrections for the rest of the claims.

10. Lines 6-10 in claim 28 are not clear as to what forms an abbreviation or a shorthand just from reading the claim. Language in the claim recites that plurality of strings of characters form an abbreviation or a shorthand. However, Examiner suspects that was not what the Applicant meant. One possible way that line 6-10 can be rewritten is "dictionary means for storing a plurality of strings of characters; each of which forms an abbreviation or a shorthand and a word corresponds to each said strings of characters," assuming that it was an apparatus claim.

Lines 10-16 recite "means for determining said word in said dictionary means which equals said word input, being actuated by the corresponding key; means for selecting a desired word among words which were selected by said means for determining said word." Examiner asserts that means for selecting is not consistent with what means for determining tries to accomplish because from reading the claim, Examiner's understanding is that there can be only one word that equals said word input from means of determining. However, means for selecting limitation in the claim seems to be written that there are more than one word from means for determining.

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Lines 28-30 in claim 28 recite "which is derived from one of relevant words and relevant words." Examiner asserts that it is not clear whether a line of text can be derived from more than one relevant word or just one relevant word.

Lines 31-40 in claim 28, which recites means for determining, as a whole is not clear or too vague. For instance, Applicant's use of a word "unique" in line 33 seems redundant since it already has been recited in line 31. Further, it is not clear to what "to be done" in line 37 refers, and Applicant should avoid using relative terms, such as etc., in line 39.

Lines 41-55 in claim 28, which recites means for selecting a desired word among said relevant words, as a whole, are too vague and indefinite. For instance, line 45 recites "which is unique and terminates with the same one as the last input...". Yet, it is not clear why the desired word has to terminate with the same one as the last input after it already has been recited as unique. Similarly, subsequent limitations should be corrected.

11. Regarding claims 28, 29 and 32, the phrase "could be" renders the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

Response to Amendment

12. The reply filed on 9/25/1999 made reference to only three documents (copies of which Applicant alleged were attached to the response) which Applicant alleged to have effected the numbering of the claims in the application: (1) original application papers in the parent

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dated 10/23/1994; (2) an amendment sent to the PTO by FAX on 10/6/1996; and (3) an amendment requesting a File-Wrapper-Continuation (FWC) application sent to the PTO by FAX on 3/2/1997. Examiner hereby makes of record that no copies of said documents were in fact attached to the response, in spite of the allegations made by Applicant. In addition, Examiner points out that the dates of the respective documents are not as alleged by Applicant, and that these are not in fact the complete set of documents effecting the numbering of the claims in the application.

In order to assist Applicant in prosecuting the application, Examiner recites the following history of the claims in the case. The parent application 08/330,573 was originally given a filing date of 10/28/1994 and an effective filing date of 6/19/1994 due to a foreign priority document.

12 (twelve) claims were initially filed in the case. The first Office Action on the merits of the case rejected claims 1-10 under 35 U.S.C. 112 (second paragraph) and 35 U.S.C. 103, and objected to claims 11 and 12 as being of improper multiple dependent form. Applicant's response filed 8/16/1996 canceled claims 1-12 and added claims 13-23. Applicant subsequently filed another amendment on 9/12/1996 adding claims 24-27. Applicant subsequently filed another amendment on 9/16/1996 canceling claims 21-23. Applicant subsequently filed another amendment on 10/6/1996 canceling claims 13-20 and 24-27, and adding claims 28-35. At this time, claims 28-35 were the only claims pending in the case. The next Office Action on the merits of the case objected to all claims and rejected all claims under 35 U.S.C. 112 (second paragraph), and was made Final.

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Applicant filed a request for File-Wrapper-Continuation (FWC) on 3/2/1997 and expressly abandoned the parent 08/330,573. On the form requesting for continuation, Applicant indicated that a Rule 62 amendment was attached, and that after entry of the amendment, the case would include 8 independent claims and a total of 24 claims. However, no such preliminary amendment was in fact attached, and no such amendment has ever been made of record in the case. The new application was assigned 08/813,247; however, due to no fault of Applicant, the request for FWC status was refused. Applicant then filed a petition on 5/27/1997 requesting the granting of a filing date in view of an accompanying amendment. However, no such preliminary amendment was in fact attached, and no such amendment has ever been made of record in the case. The petition was granted on 5/13/1998 due to recognition that there was in fact copendency between the two applications.

At that time, two preliminary amendments were outstanding in the case: one was filed 9/30/1997 attempting to claim a priority date that was in fact **after** the effective filing date of the application; another was filed on 3/16/1998 which attempted to add claims 60-62, while stating that this was a correction of the previous amendment. As discussed in the objection to claims 36-38 above, these claims are of improper dependent form because they depend upon claims 44, 49 and 57 (which are not of record in the case). On 9/9/1999, Applicant was notified that the attempted change in priority date was in error, and that the addition of claims 60-62 was also in error due to the numbering of the claims and the improper dependency. Applicant responded on by 9/25/1999 by canceling the amendment which attempted to change the priority

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date and making the statement that "*Concerning the numbering of the claims in 1.b, please refer to the contents of 3 documents **copies attached**, as mentioned below...*" (emphasis added).

However as mentioned above, no such documents were attached.

Examiner asserts that the claims are in the same state as when the Final rejection was made in the parent application, with the exception of the addition of claims 36-38; which have been objected to as being dependent on claims which are not of record in the case, and therefore have not been considered.

Conclusion

13. An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

14. This is a continuation of applicant's earlier Application No. 08/330,573. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this or earlier communications from the examiner should be directed to Rob Bourque whose telephone number is (703) 308-4998. The examiner can normally be reached on Monday - Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mike Razavi can be reached on (703) 305-4713.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

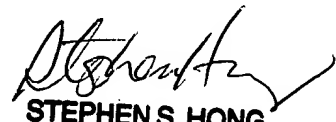
or faxed to: (703) 308-9051, (for formal communications intended for entry)

or: (703) 305-9724 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to the sixth floor receptionist at Two Crystal Park, 2121 Crystal Drive, Arlington VA.

Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.

Rob Bourque
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October 11, 1999


STEPHEN S. HONG
PRIMARY EXAMINER